

REMARKS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 19-20, 22-29, and 31-40 are presently active in this case. Claims 1-18 were cancelled by a preliminary amendment. The present Amendment amends Claims 19, 24, 26, 28, 33, and 35 without introducing any new matter nor raising new issues that would require further search and/or consideration by the Examiner, and cancels Claims 21 and 30 without prejudice or disclaimer.

The outstanding Office Action rejected Claims 19-40 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Claims 19-22, 26-31, and 35-40 were rejected under 35 U.S.C. § 103(a) as unpatentable over Husemann et al. (U.S. Patent Publication No. 2004/0199056, hereinafter “Husemann”), in view of Ylitalo et al. (U.S. Patent Publication No. 2004/0203768, hereinafter “Ylitalo”). Claims 23-25 and 32-34 were rejected under 35 U.S.C. § 103(a) as unpatentable over Husemann in view of Ylitalo, in further view of Njemanze (U.S. Patent No. 6,390,979).

In response to the rejection of Claims 19-40 under 35 U.S.C. § 112, first paragraph, Applicants respectfully traverse the rejection.

Regarding the feature “ring tone” that is recited in Claims 19 and 28, this features clearly finds non-limiting support in the specification as originally filed. In particular, the specification provides at page 6, lines 24-26 that “[t]he operational functions can comprise e.g. ringing tone, ringing volume, vibration strength, light signals, . . .” In light of this disclosure, Applicants traverse the rejection of Claims 19 and 28 under 35 U.S.C. § 112, first paragraph, and request reconsideration thereof.

Regarding the rejection of the features directed to the “voice mail box” of Claims 37-38, Applicants traverse this rejection, because the specification clearly conveys to one of

ordinary skill in the art how to make and/or use the invention as claimed. For example, Claim 37 provides “wherein the mode of operation determines whether incoming calls are accepted or directed to a voice mailbox.” In this respect, Applicants’ specification provides the following passages on page 3:

. . . in general the mode of operation can be adapted to external conditions and/or user parameters . . .
Thus, for example, the measurement of the voice activity and/or voice pitch (louder or raising the voice) can indicate an emotional stress situation for the user, in which, for example, unsolicited promotional calls or calls from certain numbers or calls in general or messages of all kinds are not necessarily desirable and/or it can indicate, for instance an automatic transfer of the calls to an answering machine.

(See specification, p. 3, ll. 1-12, portions omitted.) In other words, it is clear that the specification provides that depending on certain circumstances, a call can be accepted or directed to a voice mail box, also called an answering machine.

Applicants also respectfully submit that the claim elements need not to find literal support in the disclosure as originally filed, and features that are inherent to the disclosure do not constitute new matter. The case law has established that by disclosing in a patent application a device that inherently performs a function, a patent application necessarily discloses that function, even though it says nothing explicit concerning it. See M.P.E.P. § 2163.07(a). In addition, the application may later be amended to recite the function ***without introducing prohibited new matter***. *Id.*, see also *In re Reynolds*, 443 F.2d 384, 170 USPQ 94 (CCPA 1971); *In re Smythe*, 480 F. 2d 1376, 178 USPQ 279 (CCPA 1973).

Accordingly, Applicants traverse the rejection of Claims 37-38 under 35 U.S.C. § 112, first paragraph, and request reconsideration thereof.

Moreover, independent Claim 19 is amended to recite all the features of dependent Claim 21, and independent Claim 28 is amended to recite all the features of dependent Claim 30. Consequently, dependent Claims 21 and 30 are cancelled without prejudice or

disclaimer. In addition, dependent Claims 24, 26, 33 and 35 are amended to reflect an amendment of the respective independent claims. No new matter has been added.

In light of the amendments to the independent claims, Applicants respectfully traverse the rejection under 35 U.S.C. § 103(a), and respectfully request reconsideration of this rejection, as discussed next.

Briefly summarizing, Applicants' Claim 19 is directed to a mobile communication device. The mobile communication device has a plurality of modes of operation, where body-related parameters of an user or environmental parameters of the mobile communication device can be captured by the mobile communication device by sensors or measuring devices. The mobile communication device further includes a selection module configured *to evaluate the body-related parameters of the user and the environmental parameters of the mobile communication device*, and an operational mode module configured to adapt a respective mode of operation of the mobile communication device according to evaluation data for the body-related parameters and the environmental parameters, *wherein an environmental parameter for the environment of the mobile communication device that is able to be captured by the mobile communication device by sensors includes at least one of a noise level, an air temperature, or a light value for the surrounding area of the communication device.*

Turning now to the applied reference, Husemann is directed to a system for placing a call from a mobile telephone 108 in response to receiving a signal from a portable externally worn body relay device 104. (Husemann, Abstract, Fig.1.) Husemann explains that a patient 102 can be in contact with body-worn devices 104 that perform a health or medical related function. (Husemann, p. 2-3, ¶ [0028].) The body-worn devices 104 can communicate with a wireless unit to the mobile telephone 108, and can transmit data regarding a health condition, or can initiate distress communication. (Husemann, p. 4, ¶ [0037]). In response,

the mobile telephone 108 can perform data logging, or can make a distress call to a remote emergency unit. (Husemann, p. 4, ¶ [0037], ¶ [0038], ll. 1-3, ¶ [0039], ll. 1-4.) However, Husemann fails to teach that an environmental parameter for the environment of the mobile communication device that is able to be captured by the mobile communication device by sensors includes at least one of a noise level, as previously recited in dependent Claim 21. This is also confirmed by the pending Office Action. (Office Action, p. 5, ll. 10-14.) This feature is now recited in independent Claim 19.

However, the pending Office Action rejected this feature based on the reference Ylitalo, and assumed that the combination of Husemann and Ylitalo is proper. Applicants respectfully traverse these contentions, as discussed next.

The reference Ylitalo is directed to a system for automatically updating a wireless profile or setting of a mobile device 100, based on a geographic location of a mobile device 100. (Ylitalo, Abstract, Fig. 1.) The user can thereby identify locations that he frequently visits, for example his home 102, his automobile 108, or his office 110. (Ylitalo, ¶ [0040].) For the mobile device 100 to detect the location, signal generators 106, 114, 118, 122 can be installed at the respective locations. (Ylitalo, ¶¶ [0038], [0043], Fig. 1.) Furthermore, Ylitalo explains in his paragraph [0077] that additional parameters may also be used in addition to the location of the mobile device to automatically select profiles, for example, the time of day, the calendar date, the day of the week. (Ylitalo, ¶¶ [0077], ll. 1-8.) Ylitalo explains that when the user's automobile profile is "selected using the automobile profile point," it can also reject work-related phone calls. (Ylitalo, ¶¶ [0077], ll. 8-12.) As a consequence, Ylitalo explains that the change of profile results in an adjustment to the volume of the ring tone to accommodate the relatively noisy automobile environment. (Ylitalo, ¶¶ [0077], ll. 12-16.) But Applicants' independent Claim 21 requires that an environmental parameter for the environment of the mobile communication device *is captured by the mobile communication*

device by sensors includes at least one of a noise level. Ylitalo fails to teach such a feature, because his system merely detects a location by using the automobile profile point 114, and does not capture a noise level at all.

Therefore, the cited passages of Husemann and Ylitalo, taken in any proper combination, fail to teach every feature recited in Applicants' Claim 19, so that Claim 19 is believed to be patentably distinct over Husemann and Ylitalo. Accordingly, Applicants respectfully traverse, and request reconsideration of the rejections based on these references.

Moreover, Applicants respectfully request reconsideration of the rejection of some of the features of Applicants' dependent claims. For example, dependent Claim 39 requires that the selection module is further configured to evaluate ***a body position of the user and a noise level of an environment***. In other words, ***both*** (i) the body position of the user has to be evaluated, and (ii) the noise level of an environment. The pending Office Action rejected these features as being taught by the reference Ylitalo in paragraphs [0034]-[0035] and [0077]. But as discussed above, the cited passages are silent on both features (i) and (ii). Therefore, Applicants respectfully request reconsideration of the rejection of the dependent claims.

Independent Claim 28 recites features that are analogous to the features recited in independent Claim 19, but directed to a method. In addition, independent Claim 28 has been amended analogously to changes that are made to independent Claim 19. Accordingly, for the reasons stated above for the patentability of Claim 19, Applicants respectfully submit that the rejections of Claim 28, and the rejections of all associated dependent claims, are also believed to be overcome in view of the arguments regarding independent Claim 19.

The present amendment is submitted in accordance with the provisions of 37 C.F.R. §1.116, which after Final Rejection permits entry of amendments placing the claims in better form for consideration on appeal. As the present amendment is believed to overcome

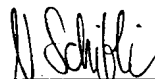
outstanding rejections under 35 U.S.C. § 112, first paragraph, and 35 U.S.C. § 103(a), the present amendment places the application in better form for consideration on appeal. In addition, the present amendment is not believed to raise new issues because the changes to independent Claims 19 and 28 merely recite features previously introduced in dependent Claims 21 and 30, and the changes to Claim 24, 26, 33 and 35 are of a minor nature. It is therefore respectfully requested that 37 C.F.R. § 1.116 be liberally construed, and that the present amendment be entered.

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 19-20, 22-29, and 31-40 is earnestly solicited.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicants' undersigned representative at the below listed telephone number.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



James J. Kulbaski
Attorney of Record
Registration No. 34,648

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 08/07)

Nikolaus P. Schibli, Ph.D.
Registered Patent Agent
Registration No. 56,994